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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,784	07/06/2001	Kinya Washino	FNI-02503/03	2825
25006 7590 09/14/2007 GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			EXAMINER LEE, MICHAEL	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/900,784

Applicant(s)

WASHINO ET AL.

Examiner

M. Lee

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-63 and 65-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-63, 65-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. **Pease disregard the Non-Compliant Amendment Notice mailed on 8/17/07 because it is incorrect regarding amendment requirements to reissue applications. The Office apologizes for the confusion.**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 51-63, and 65-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not support the new limitation which the video program source material and the supplemental information are recorded together on a computer-readable medium. This contradicts to the original disclosure in which the two signals are recorded on separate medium.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 60 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 60, "the storage" lacks proper antecedent basis.

In claim 74, the "recording apparatus" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 51-63, and 65-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (5,218,672).

Regarding claim 51, Morgan discloses an offline editing system showing one or more inputs (50, 3.5" FDD), and a hard disk for storing the edit list (col. 9, lines 46-47), except the computer readable medium for storing the video and the supplement information as claimed. In any event, Morgan teaches that the video may be stored in a magnetic disk drive, which means a hard drive (col. 11, line 66, to col. 12, line 2). Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to store both the video signal and the edit list on the hard disk to perform the well known functions as claimed. It should be noted that the special effect and splice codes meet the scripting, casting or staging information as claimed (see col.

6, lines 58-62). In addition, the "Overlay" and "Insert" modules (col. 9, lines 48-61) have the similar effects as the scripting, casting or staging information as claimed because they are instruction commands or codes for controlling the edit controller.

Regarding claim 52, see the edit list.

Regarding claim 53, Morgan does not specify that the scripting or staging information relate to the control of camera positioning or orientation as claimed. In any event, Morgan teaches that the videodisk players can be selectively controlled and played back according to a control list or codes (col. 8, lines 32-38). In addition, Morgan further teaches a sync-roll module which enables the user to viewed simultaneously a set of synchronous takes while marking "in" and "out" frames of desired ones of the takes to generate and edit list (col. 7, lines 1-6). By using the same analogy, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the edit system of Morgan so that the it could be used to control all kinds of electronic device, including cameras, because the edit list or control codes are intended to control all kinds of electronic devices as implied by Morgan (col. 8, lines 15-31).

Regarding claim 54, Morgan does not specify that the scripting or staging information relates to the positioning, orientation, or physical characteristics of scenery, props or actors as claimed. In any case, Morgan teaches a text prompt display function which is intended to display all kinds of text message including positioning, orientation, and physical characteristics of objects (see col. 7, lines 7-11).

Regarding claim 55, see col. 5, line 65, to col. 6, line 5, and col. 6, lines 46-54.

Regarding claim 56, see col. 6, lines 46-53.

Regarding claim 57, see col. 7, line 7, to col. 8, lines 14.

Regarding claim 58, the "in" and "out" markings on the desired cameras meet the camera switching time as claimed (col. 7, lines 1-6).

Regarding claim 59, as aforementioned, see col. 6, lines 57-62.

Regarding claim 60, Morgan does not specify that the storage (computer readable medium) forms part of a camcorder as claimed. The examiner takes Official Notice that a camcorder normally includes a storage device for storing video data. Thus, using a camcorder to store the video data and edit list in Morgan would have been obvious to one of ordinary skill in the art at the time that the invention was made because edited video data and edit list in Morgan is intended to save on any memory device.

Regarding claim 61, the video data and edit list in Morgan are stored separately.

Regarding claim 62, see col. 3, line 65.

Regarding claim 63, see col. 7, lines 21-27.

Regarding claims 65-77, in addition of above, Morgan does not specify the source material is recorded in digitally compressed form on a computer readable medium as claimed. In any event, as aforementioned, Morgan teaches that the video and audio data can be recorded on random access memory units, such as a hard drive, other than laser disks (col. 11, line 66, to col. 12, line 2). In order to conserve memory space, the video and audio data must be compressed. Hence, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to

include a compression device into Morgan so that the data volume could be reduced and stored into a limited hard drive disk.

Response to Arguments

8. Applicant's arguments with respect to claims 51-63, and 65-77 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number 571-272-7349. The examiner can normally be reached on Monday through Thursday from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz, can be reached on 571-272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. Lee
Primary Examiner
Art Unit 2622